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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/436,171	11/09/99	BLECKMANN	A BEIERSDORF59

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EXAMINER

WELLS, L

ART UNIT

PAPER NUMBER

1619

DATE MAILED: 10/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/436,171

Applicant(s)

BLECKMANN ET AL.

Examiner

Lauren Q Wells

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Specification

1. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because of misspelled words, missing words, and improper grammar.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

1. Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claim 6, the phrases "such as" and "for example" render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2, 4, and 5 recite the broad recitation "greater than 80% weight", "at least 50% by weight", and "comprise from 0.01-10%", respectively, and the claim also recites "in particular greater than 85% by weight", "preferably of more than 75% by weight", and "preferably 0.25-1.25%", respectively, which is the narrower statement of the range/limitation.

5. Claim 6 is objected to because of the following informalities: incorrect use of parenthesis and brackets. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Hansenne et al. (6,051,211); PTO-892 dated 10/13/00.

The instant invention discloses a water-in-oil emulsion comprising water, water-soluble substances, lipids, at least one surface-active substance of the general formula (I), and at least one cationic polymer.

Hansenne et al. teach a water-in-oil cosmetic emulsion comprising at least one polyalkylpolyethersiloxane and at least one polyoxyalkylenated glycol fatty acid ester polymer as a surface active emulsifier. Hansenne et al. (Col. 4, lines 6-9) teach polyethylene glycol dipolyhydroxystearate, marketed under the trademark "Arlacel P 135" that falls within formula (I) as the fatty acid ester of the emulsifying polymer. Hansenne et al. (Col. 4, lines 15-31) teach exemplary oils such as petrolatum, polydecene, and paraffin as the oil component of the emulsion. Hansenne et al. teach (Col. 5, lines 3-9) thickeners which can be selected from modified or unmodified guar gums and celluloses that can describe cationic polymers. Hansenne et al. teach (Example 1 & 2) lipophilic constituents as comprising 20% weight and water as comprising q.s. for 100%. Therefore, those claims drawn to water in oil emulsions comprising water or

water soluble substances totaling 80% by weight, a content of lipids, emulsifiers and lipophilic constituents of less than 20% by weight, formula (I), where formula (I) is polyethylene glycol-30 dipolyhydroxystearate, and cationic polymer(s), is anticipated.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansenne et al. in view of Seidel et al. (5,830,483); PTO-892 dated 10/13/00.

The instant invention discloses a water-in-oil emulsion comprising water, water-soluble substances, lipids, at least one surface-active substance of the general formula (I), and at least one cationic polymer.

Hansenne et al. teach a water-in-oil cosmetic emulsion comprising at least one polyalkylpolyethersiloxane and at least one polyoxyalkylenated glycol fatty acid ester polymer. Hansenne et al. (Col. 4, lines 6-9) teach polyethylene glycol dipolyhydroxystearate, marketed under the trademark "Arlacel P 135" which falls within formula (I). Hansenne et al. (Col. 4, lines 15-31) teach exemplary oils such as petrolatum, polydecene, and paraffin. Hansenne et al. teach (Col. 5, lines 3-9) thickeners which can be selected from modified or unmodified guar gums and celluloses which describe cationic polymers. Hansenne et al. teach (Example 1 & 2) lipophilic constituents as comprising 20% weight and water as comprising q.s. for 100%.

Seidel et al. teach an oil-in-water emulsion comprising at least one cationic and one anionic emulsifier. Seidel et al. teach (Col. 4, lines 35-44) paraffin oils, mono/di/triglycerides, fatty alcohols, fatty alkyl alkanolamides, silicone oils, esters of fatty acids, and dialkyl ethers as oils. Seidel et al. teach (Table 1) paraffin oil as the primary oil used in the composition. Seidel et al. teach (Col. 4, lines 65-67 and Col. 5, lines 1-5) cationic polymers such as quaternized cellulose ethers, polysiloxanes containing quaternary groups, dimethyl diallylammonium chloride polymers, acrylamide dimethyl diallylammonium chloride copolymers, dimethyl aminoethyl methacrylate/vinyl pyrrolidone copolymers quaternized with diethyl sulfate, vinyl pyrrolidone/methoimidazolinium chloride copolymers and quaternized polyvinyl alcohol. Seidel et al. teach (Col. 10, lines 11-13) cationic polymers present in the emulsion from about 0.4-0.8% by weight.

Hansenne et al. do not teach some of the specific claimed cationic polymers. Hansenne et al. do not teach the entire range of cationic polymers or oil phase constituents.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cationic polymers of Seidel et al. for modified guar gums and celluloses of Hansenne et al. so as to produce a water-in-oil emulsion with a desired thickness/viscosity because of the expectation of achieving an emulsion with a rich appearance and good flow behavior as taught by Seidel et al. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the proportions of cationic polymers and oil phase constituents taught in

Hansenne et al. for the proportions taught by Seidel et al. because of the expectation of producing an emulsion that only needs a small quantity of emulsifier to achieve a desired viscosity as taught by Seidel et al.

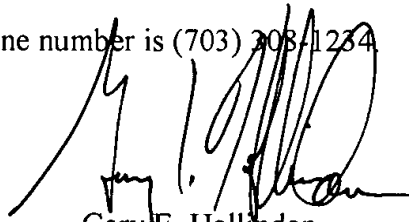
The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary E Hollinden can be reached on (703) 308-4521. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Gary E. Hollinden
Primary Examiner
Art Unit 1619

lqw
October 20, 2000